

Appl. No. 10/719,700  
Amdt. dated August 17, 2005  
Reply to Office Action mailed February 17, 2005

### **REMARKS**

In the Office Action mailed February 17, 2005, the Examiner raised a restriction requirement, identifying two distinct inventions, as follows:

Group I: Claims 1-12 and 20, drawn to a golf club/golf club shaft.

Group II: Claims 13-19, drawn to a method of preparing a golf club shaft.

Also, in the Office Action, claims 1-12 and 20 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent Appl. Publ. No. 2004/0178533 to Haas ("Haas") in view of European Patent No. 0 433 843 ("the EPO '843 patent") and Japanese Application No. 11-206936 ("the Japanese '936 application"). Claim 11 was rejected under U.S.C. § 103(a), as allegedly obvious over Haas in view of the EPO '843 patent and the Japanese '936 application, and in further view of U.S. Patent No. 6,334,817 to Ezawa ("the Ezawa patent"). Claim 12 was rejected under U.S.C. § 103(a), as allegedly obvious over the Haas patent in view of the EPO '843 patent and the Japanese '936 application, and in further view of U.S. Patent No. 5,885,166 to Shiraishi ("the Shiraishi patent").

Applicants hereby confirm the election of Group I. Applicants reserve the right to file a divisional application directed to unelected Group II. By this Amendment, Applicants amended claims 1 and 2-5 and added claims 21-28. Applicants also have canceled claims 6-20, rendering several rejections moot. Pending claims 1-5 and 21-28 are readable on Group I. Below, Applicants discuss the obviousness rejection of pending claims 1-5 and discuss newly added claims 21-28.

#### **I. Obviousness Rejection of Claims 1-5**

As mentioned above, claims 1-5 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over Haas in view the EPO '843 patent and the Japanese '936 application.

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As amended, claim 1 recites among other things, tubular member having a paint layer provided along a majority of the length of the tubular, wherein the paint layer provides a first color. A heat-transfer decal is provided having a length between about 5% to about 90% of the longitudinal length of the tubular member is affixed to the paint layer such that the decal circumferentially surrounds the tubular member. The decal comprises a second color extending laterally 360 degrees about the tubular member. The second color is different from the first color.

On page 4, the Examiner cites the EPO '843 patent as disclosing a golf club shaft (Fig. 7), including "a decorative layer over the entire surface of the shaft (DERWENT, Equivalent Abstract), a decal having variable width profile . . . (Fig. 3, DERWENT, Equivalent Abstract)."

Applicants respectfully disagree with this characterization of the EPO '843 patent. Based on the translated abstract provided, it appear that the EPO '843 patent is not directed to a heat-transfer decal at all, let alone a heat-transfer decal having all of the features set forth in claim 1. In contrast, the EPO '843 patent discloses a decorative layer ("decorative support 7") formed of fabric impregnated with synthetic resin and is secured by an outer layer of a glass fiber (13). (DERWENT, Equivalent Abstract, Fig. 8). This is significantly different from a heat-transfer decal, as set forth in claim 1, requiring a different and complex installation process. Moreover, the EPO '843 patent does not disclose, or suggest, a golf club shaft having a paint layer of a first color and a heat-transfer decal comprising a second color extending laterally 360 degrees about the tubular member.

None of the other cited references provide for the shortcomings of the EPO '843 patent. Accordingly, the obviousness rejection of claims 1-5 is improper and should be withdrawn.

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## II. New Claims

By this Amendment, Applicants have added claims 21-28. No new matter has been added. Claims 21-27 depend from independent claim 1, adding features that further define the invention and distinguish over the cited references. Independent claim 28 also incorporates detailed features that further define the invention and distinguish over the cited references.

## III. Conclusion

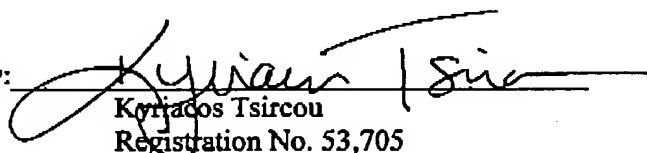
The foregoing remarks should place this application in condition for allowance. If any matters remain outstanding after consideration of this Amendment that the Examiner believes might be expedited by a telephone conference with Applicants' representative, he is respectfully requested to call the undersigned attorney at the number indicated below. As indicated in the transmittal form filed herewith, please charge any fees due in connection with this filing to our Deposit Account No. 19-1853.

Date: August 17, 2005

Respectfully Submitted,

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